

**REMARKS**

In the Office Action, claims 1-11, 13-15, and 17-27 were rejected. By this response, claims 1, 10, 15, and 19-24 are amended. No new matter has been added. Upon entry of these amendments, claims 1-11, 13-15, and 17-27 will remain pending in the present application. All are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

**Claim Rejections Under 35 U.S.C. § 101**

In the Office Action, claims 25-27 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner stated that “[c]laims 25-27 recite an ‘image ... stored on computer-readable medium,’ which does not impart *functionality* to a computer or computing device, and is thus considered nonfunctional descriptive material.” *See* Office Action, page 2. (Emphasis in original). Applicants respectfully traverse this rejection.

As discussed in a previously filed Response, Applicants assert that the image recited by claims 25-27 are not intended to impart functionality to a computer or computing device, as alleged by the Examiner. *See* Response to Office Action Mailed June 26, 2007, pages 9-10. Rather, claims 25-27 are meant to be interpreted as **product-by-process** claims in accordance with Section 2173.05(p) of the M.P.E.P which states:

A product-by-process claim, which is a product claim that **defines the claimed product in terms of the process by which it is made**, is proper. *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); *In re Pilkington*, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969); *In re Steppan*, 394 F.2d 1013, 156 USPQ 143 (CCPA 1967). A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112,

second paragraph, so long as it is clear that the claim is directed to the product and not the process.

M.P.E.P. § 2173.05(p). (Emphasis added). The M.P.E.P. further states that “the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.” M.P.E.P. § 2113. (Emphasis added).

With the foregoing guidelines in mind, Applicants reiterate that the “images” recited by claims 25, 26, 27 are not, as alleged by the Examiner, meant to impart functionality to a computer, but rather are the *resulting product* created by the processes recited by independent claims 1, 10, and 15, respectively. Moreover, Applicants submit that the claimed images of claims 25, 26, and 27 can *only* be defined by their associated processes, as recited by independent claims 1, 10, and 15, respectively. Therefore, because claims 25, 26, and 27 each recite a claimed product (e.g., an image) in terms of the *process* by which the claimed product is created (the processes of claims 1, 10, 15), Applicants submit that claims 25, 26, and 27 are clearly *product-by-process* claims, which are proper under Section 2173.05(p) of the M.P.E.P.

Applicants further contend that the resulting images of claims 25-27 are different from those obtained in the prior art due to the novel method of selectively obfuscating indicia in the resulting image, as disclosed in the present application. *See* Application, pages 1-2. Moreover, the resulting images, created due to the efficient and automated removal of sensitive data, are particularly useful in medical settings in which legal and ethical considerations govern that sensitive information should not be stored, shared, or transmitted. *See id.* at page 2. Further, Applicants note that claims 25-27 were each previously amended to specify that the resulting image is stored “on computer readable medium,” and is thus clearly tangible. Accordingly, Applicants submit that the resulting

images recited by claims 25, 26, and 27 are the useful, concrete, and tangible resulting product from the processes recited by claims 1, 10, and 15, respectively, thus constituting statutory subject matter under Section 101. For at least these reasons, Applicants respectfully request withdrawal of the Section 101 rejections of claims 25-27.

#### **Claim Rejections Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-7, 10, 13, 14, 19, 20, 22, 23, 25, and 26 under 35 U.S.C. § 102(e) as being anticipated by Siegel. Applicants respectfully traverse this rejection.

#### ***Legal Precedent***

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *See Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir.1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *See In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir.1990). That is, the prior art reference must show the *identical invention* “in as complete detail as contained in the ... claim” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Thus, for anticipation, the cited reference must not only disclose all of the recited features but must also disclose the *part-to-part relationships* between these features. *See Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 486 (Fed. Cir.1984). Accordingly, Applicants need only point to a single element or claimed relationship not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

#### ***Independent Claims 1, 10, 19, 20, 22, 23, 25, and 26***

As amended, independent claims 1 and 10 each recite methods comprising, *inter alia*, “identifying one or more region in which indicia appear in the image, including text in horizontal and vertical orientations.” (Emphasis added). Amended independent

claims 19 and 20 each recite systems comprising “means for identifying one or more region in which indicia appear in the image, including text in *horizontal and vertical orientations*.” (Emphasis added). Amended independent claims 22 and 23 each recite code stored on a computer readable medium encoding routines for “identifying one or more region in which indicia appear in the image, including text in *horizontal and vertical orientations*.” (Emphasis added). Independent claims 25 and 26, as discussed above, are product-by-process claims reciting images produced by the processes recited by independent claims 1 and 10, respectively. Therefore, the recited image of claims 25 and 26 would be produced using the above-recited step of identifying one or more region in which indicia appear in the image, including text in horizontal and vertical orientations. Applicants respectfully submit that Siegel does not teach or suggest identifying regions of indicia which include both horizontally *and* vertically oriented text.

Siegel generally describes the use of optical character recognition (OCR) in preparing, in response to a user-initiated search query, substitute images for images stored in a general library context consisting of printed works, such as books, magazines, newspapers, manuals, guides, references, articles, reports, etc. *See* Siegel, col. 1, lines 21-25; col. 6, lines 40-43; col. 7, lines 4-12. The substitute images may be modified with respect to the original image for suppression (or non-suppression) of certain indicia. *See id.* According to Siegel, the suppression (or non-suppression) of features may be beneficial when the reproduction of certain features of a page image is restricted for copyright or contractual reasons. *See id.* at col. 6, lines 7-15.

In generating the substitute images, Siegel relies on one or more suppression (or non-suppression) criteria. For example, Siegel discloses that non-suppression criteria may simply include a user’s search terms initiated in a query. Based on the search terms, a replacement image of a page containing the desired text may be generated and displayed, for example, including only the text designated by the search terms or, in some implementations, both the text corresponding to the search terms as well as up to a

number of adjacent text measured by the number of words from the search term. *See id.* at col. 7, lines 56-64. In another example, Siegel discloses that suppression criteria may be content specific, such as suppressing all numbers in a page in a recipe or a mathematical equation. *See id.* at col. 7, lines 64-67. Figs. 4-6 and 11-12 of Siegel illustrate various examples of how the entered search terms may be used to generate the replacement images. However, Applicants note that *each* of the identified regions (particularly in Figs. 5 and 12) illustrate that only horizontally oriented text is identified via the OCR process. Indeed, there does not appear to be any teaching or suggestion that the process disclosed by Siegel is even capable of identify regions of *vertically* oriented text.

Further, Applicants submit that there does not appear to be any implicit teaching or suggestion that the process described in Siegel is applicable to the identification of regions containing *vertically* oriented text. As stated above, the suppression (or non-suppression) of features (*e.g.*, indicia) in the substitute images, as disclosed by Siegel, appears to be based on user-entered search terms applied to a library of printed works, such as books, magazines, newspapers, or the like, which would generally comprise only *horizontally* oriented text. Therefore, Applicants submit that one conducting a search in accordance with the method of Siegel to locate a particular printed work or works from a library of printed works would not contemplate searching for vertically oriented text. Accordingly, Applicants submit that Siegel, at best, discloses identifying regions of indicia including *only* horizontally oriented text.

For at least the reasons discussed above, Applicants assert that Siegel does not appear to contain any explicit or implicit teaching that the identified regions containing indicia may include *vertically* oriented text in addition to horizontally oriented text, as would be required to anticipate the rejected claims. In view of this deficiency, among others, Siegel cannot be relied upon to establish a *prima facie* case of anticipation against independent claims 1, 10, 19, 20, 22, 23, 25, and 26. As such, Applicants respectfully

request withdrawal of the Section 102 rejections and allowance of independent claims 1, 10, 19, 20, 22, 23, 25, and 26, as well as those claims depending therefrom.

**Claim Rejections Under 35 U.S.C. § 103(a)**

In the Office Action, the Examiner rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Siegel in view of Official Notice with regard to grey scale images and further rejected claims 8, 11, 15, 17, 18, 21, 24, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Siegel in view of Jordan, U.S. Patent No. 6,823,203 (hereinafter referred to as “Jordan”). Applicants respectfully traverse these rejections.

***Claims 15, 21, 24, and 27***

Applicants note that amended independent claims 15, 21, and 24 each recite identifying one or more region in which indicia appear in an image, including text in horizontal and vertical orientations. Independent claim 27, as discussed above, is a product-by-process claim reciting an image produced by the process recited by independent claim 15. Therefore, the recited image of claim 27 would be produced using the above-recited step of identifying one or more region in which indicia appear in an image, including text in horizontal and vertical orientations.

As discussed above with regard to the Section 102 rejections, Siegel fails to teach or suggest, either explicitly or implicitly, identifying regions of indicia containing *vertically* oriented text. Instead, Siegel, at best, appears *only* to describe identifying regions of *horizontally* oriented text. Moreover, Jordan, which the Examiner relied upon solely for the teaching of medical diagnostic images, fails to obviate the deficiencies of Siegel. Therefore, Applicants submit that Siegel and Jordan, alone or in combination, fail to establish a *prima facie* case of obviousness against independent claims 15, 21, 24, or 27. As such, Applicants respectfully request withdrawal of the Section 103 rejections and allowance of independent claims 15, 21, 24, and 27, as well as any claims depending therefrom.

***Claim 9: Traversal of Examiner's use of Official Notice***

Although claim 9 is believed to be allowable at least by virtue of its dependency from independent claim 1, Applicants further challenge the Examiner's use of Official Notice in combination with Siegel. Applicants note that the Examiner has relied on Official Notice solely for the teaching that encoding images in a grey scale format is allegedly well-known in the art. *See id.* at page 6. However, even if the encoding of images into grey scale format could be inferred from unidentified art, absent a showing that the remaining features of claim 9 are also disclosed, the mere teaching of grey scale images is insufficient to anticipate or render obvious claim 9. Because the Examiner's use of Official Notice does not provide the requisite likelihood of success in this regard, it is therefore traversed. Accordingly, the withdrawal of the rejection of claim 9 under Section 103 is also respectfully requested.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: March 14, 2008

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